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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,427	03/31/2004	Paul Buchheit	060963-5008US	8813
24341 7590 09/10/2008 MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306				
EXAMINER				
STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
2153				
MAIL DATE		DELIVERY MODE		
09/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,427

Applicant(s)

BUCHHEIT ET AL.

Examiner

AARON STRANGE

Art Unit

2153

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 20080509
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

Response to Arguments

2. While the grounds of rejection have been changed in response to Applicant's amendments, the Examiner must respectfully disagree with Applicant's assertion that Moody fails to teach returning a list of identified conversations in response to a search query (Remarks 12).

Moody clearly discloses that users may "Search for Messages that Include Search Terms and All Related Messages", and that the results of such a search will include a list containing "the message that included the search terms 564 and the list of messages related thereto" (§57). Moody further discloses that the "messages related thereto" may be messages in the same "thread" (§57). The term "thread" is a well known term of art that means a series of messages that are created as replies to an original message and/or each other. A "thread", as used in the art, falls well within the broadest reasonable interpretation of the term "conversation", and each thread typically includes a plurality of messages.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification makes no reference to the term "computer

readable storage medium”, which appears in claims 32-37. Applicant must amend the specification and/or the claims to provide clear support or antecedent basis for the term, taking care to ensure that no new matter is introduced.

The portion of the specification cited by applicant as allegedly providing support for the term (§143) merely describes that the conversation server may include various forms of “memory”, but fails to describe the term “computer readable storage medium”.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-22 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157).

6. With regard to claim 15, Moody discloses a method of searching conversations, comprising:

on a server: (threading service 110 may be on server 108)(¶24)

receiving a search query from a client (client inputs search terms into query box 564)(¶54-57);

identifying at least one conversation (thread) relevant to the search query (messages containing the search term, and all messages in the same thread are identified)(¶57), the at least one conversation having two or more messages (at least the message containing the search term and the related message)(¶57) sharing a common set of characteristics that meet predefined criteria (the messages are part of the same "thread") and a respective conversation identifier (thread identifier)(¶57); and returning the conversation to the client a list of the identified conversations as a search result to the search query (conversations containing the search terms are returned to the client)(¶57-60).

Moody fails to specifically disclose that the list of conversations includes at least two conversations.

However, it is clear from the disclosure of Moody that the system will return a list of all conversations satisfying the search criteria. While Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody's disclosure to at least suggest such an embodiment.

Therefore, it would have been obvious to one of ordinary skill in the art to permit the search results to include at least two conversations relevant to the search terms.

7. With regard to claim 16, Moody further discloses that the identifying the conversation includes identifying a first message relevant to the search query (the message containing the search term)(¶57).

8. With regard to claim 17, Moody further discloses associating the first message to the conversation based at least in part on a subject of the message (messages that are part of the same share a "subject") (¶57) and information other than the subject of the message (keywords in the message) (¶57).

9. With regard to claim 18, Moody further discloses that associating the first message to the conversation based in part on information other than a normalized version of the subject of the message (keywords in the message) (¶57).

10. With regard to claim 19, Moody further discloses that associating the first message to the conversation based at least in part on a subject of the message (messages that are part of the same share a "subject") (¶57) and information other than one or both of a references field and an in-reply-to field (keywords in the message) (¶57).

11. With regard to claim 20, Moody further discloses a method of searching messages, comprising:

searching a message repository (Fig. 1 #110) to identify one or more messages (Fig. 5 #564) relevant to a search query, wherein each identified message is associated with a respective conversation of a plurality of conversations (Fig. 2 #224), each conversation having a respective conversation identifier (a thread identifier is inherently present to identify all messages in a thread), wherein at least one respective

conversation of the plurality of conversations comprises two or more messages sharing a common set of characteristics that meet predefined criteria (at least the message containing the search term and the related message are part of the conversation) (¶0057);

identifying the respective conversation identifiers of the conversations associated with the one or more identified messages (each thread is identified and returned to the user) (¶0057);

creating a list of one or more conversations, each of the conversations in the list corresponding to a respective identified conversation identifier (¶0057-60); and

producing at least a portion of the list of one or more conversations as the search result (threads containing the search terms are returned and displayed)(¶0057-60).

Moody fails to specifically disclose that the list of conversations includes at least two conversations.

However, it is clear from the disclosure of Moody that the system will return a list of all conversations satisfying the search criteria. While Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody's disclosure to at least suggest such an embodiment.

Therefore, it would have been obvious to one of ordinary skill in the art to permit the search results to include at least two conversations relevant to the search terms.

12. With regard to claim 21, Moody further discloses that associating the first message to the conversation based in part on information other than a subject of the message (keywords in the message)(¶57).

13. With regard to claim 22, Moody further discloses that associating the first message to the conversation based in part on information other than a normalized version of the subject reference of the message (keywords in the message)(¶57).

14. Claims 32-37 are rejected under the same rationale as claims 15-20, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/
Supervisory Patent Examiner, Art Unit 2153
/A. S./
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